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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,722	08/06/2003	Donald C. McCarthy	2380 (GP-01-25)	2014
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FERRELLS, PLLC P. O. BOX 312 CLIFTON, VA 20124-1706			EXAMINER GROSSO, HARRY A	
			ART UNIT	PAPER NUMBER
			3727	
DATE MAILED: 02/08/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/635,722

Applicant(s)

MCCARTHY ET AL.

Examiner

Harry A. Grosso

Art Unit

3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-161 is/are pending in the application.
- 4a) Of the above claim(s) 33-75 and 97-161 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 and 76-96 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/19/03, 12/9/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-32 and 76-96, drawn to a tumbler, classified in class 220, subclass 703.
  - II. Claim 33-75 and 97-161, drawn to a method of making the tumbler, classified in class 264, subclass 523.
2. Inventions of Group II and Group I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product could be made by other processes such as vacuum forming.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

3. During a telephone conversation with Mr. Michael Ferrell on January 25, 2006 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-32 and 76-96. Affirmation of this election must be made by applicant in replying to this Office action. Claims 33-75 and 97-161 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-7, 9, 13-32, 76-80, 83-87 and 89-96 are rejected under 35 U.S.C. 102(e) as being anticipated by Sandstrom et al (6,866,905) (Sandstrom).

The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

6. Regarding claims 1-7, 9, 20 and 25-30, Sandstrom discloses a stackable PET tumbler formed by injection blow-molding which would constitute injection molding a preform and blow molding it. Sandstrom discloses the tumbler with a rigidity index of 1.84 ( C, Table 4) but not 4 or 5, however, the rigidity index would appear to be an inherent property of the material and the tumbler of Sandstrom being made of PET would meet the requirements.

7. Regarding claim 13, the tumbler has a fortified rim (Column 4, lines 5-7).
8. Regarding claims 14-17 and 21-24, Sandstrom does not disclose a blow-up ratio, however, examiner deems the blow-up ratio to be directed to process limitations and does not materially affect the structure of the product.
9. Regarding claims 18, 19, 31, 32, 77 and 78, Sandstrom discloses a tumbler with a circular cross-section near the top of the tumbler and a cross-section of curved and linear segments at the bottom of the tumbler (Figures 1A-1C and 3A-3C).
10. Regarding claims 76, 79 and 80, Sandstrom discloses a stackable PET tumbler with the upper aperture generally larger than the base and having a fortified rim
11. Regarding claims 83 and 84, Sandstrom discloses a tumbler having a weight of about 25 grams (C, Table 4).
12. Regarding claims 85-86, Sandstrom discloses a tumbler volume of about 16-20 ounces, and about 20 ounces would include volumes slightly exceeding 20 ounces (column 5, lines 46-47).
13. Regarding claims 89 and 90, Sandstrom discloses a taper of 4.5-10 degrees (column 4, lines 54-55).
14. Regarding claim 91, Sandstrom discloses a tumbler with a reverse taper (Figure 17A).
15. Regarding claims 92 and 93, Sandstrom discloses a smooth sidewall adjacent the rim (Figure 1A) and the fortified rim has a thickness of 1.5 - 6 times the adjacent sidewall thickness (column 4, lines 13-15)

16. Regarding claims 94-96, Sandstrom discloses a wall caliper of 0.050 inches to 0.500 inches.

17. Claims 1-7, 9, 13-18, 20-31, 76, 77, 79, 80, 85, 86, 91, 92, and 94-96 are rejected under 35 U.S.C. 102(b) as being anticipated by Turner et al (5,449,089) (Turner).

18. Regarding claims 1-7, 9, 20 and 25-30, Turner discloses a stackable PET tumbler formed by injection blow-molding a tumbler which would constitute injection molding a preform and blow molding it (column 2, lines 7-13 and lines 57-59). Furthermore, the tumbler being prepared by blow molding an injection molded preform is considered to be a product by process limitation that does not materially affect structure. Turner does not disclose the tumbler with a rigidity index, however, the rigidity index would appear to be an inherent property of the material and the tumbler of Turner being made of PET would meet the requirements.

19. Regarding claim 13, the tumbler has a fortified rim (Figure 1).

20. Regarding claims 14-17 and 21-24, Turner does not disclose a blow-up ratio, however, examiner deems the blow-up ratio to be directed to process limitations and does not materially affect the structure of the product.

21. Regarding claims 18, 31, and 77, Turner discloses a tumbler with a circular cross-section.

22. Regarding claims 76, 79 and 80, Turner discloses a stackable PET tumbler with the upper aperture generally larger than the base and having a fortified rim

23. Regarding claims 85-86, Turner discloses a tumbler volume of 20 ounces, (column 3, lines 64-65).

24. Regarding claim 91, Turner discloses a tumbler with a reverse taper (Figure 1).
25. Regarding claim 92, Turner discloses a smooth sidewall adjacent the rim (Figure 1).
26. Regarding claims 94-96, Turner discloses a tumbler with a wall caliper of 0.040 inches (column 3, lines 12-14).

***Claim Rejections - 35 USC § 103***

27. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

28. Claims 83, 84, 87-90 and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turner.
29. Regarding claims 83 and 84, Turner discloses the invention except for the weight of the tumbler. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made a tumbler having a weight of 25-100 grams since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).
30. Regarding claims 87 and 88, Turner discloses the invention except for sizes greater than 20 ounces. It would have been an obvious matter of design choice to make the tumbler in sizes greater than 20 or 30 ounces since such a modification would have involved a mere change in the size of a component. A change in size is generally

recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

31. Regarding claims 89 and 90, Turner discloses the invention with tapered walls but does not disclose the angle of taper. It would have been an obvious matter of design choice to use a taper of about 3-8 degrees as claimed, since applicant has not disclosed that the taper used solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with a variety of tapers. Turner would be capable of having the taper claimed as well.

32. Regarding claim 93, Turner discloses the invention except for the thickness of the fortified rim. It would have been an obvious matter of design choice to make the rim thickness 1.5 to 10 times the thickness of the adjacent sidewall since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

33. Claims 8 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turner in view of Boyd et al (6,413,466). Turner discloses the invention except for the crystallinity of the sidewall. Boyd et al discloses a PET container with a crystallinity in the sidewalls exceeding 30% ( column 3, lines 24-26). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the crsytallinity exceeding 30% as disclosed by Boyd et al in the tumbler disclosed by Turner to improve the tumbler's ability to maintain its material integrity.



34. Claims 81 and 82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turner in view of Takahashi et al (6,436,497) (Takahashi).

35. Regarding claims 81 and 82, Turner discloses the invention except for the intrinsic viscosity of the material. Takahashi discloses a PET container formed from material having an intrinsic viscosity of 0.5 to 1.5 (column 3, lines 42-44). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of PET with intrinsic viscosity of 0.5 to 1.5 as disclosed by Takahashi in the tumbler disclosed by Turner since it is known in the art to make containers from PET of this intrinsic viscosity.

36. Claims 19, 32 and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turner in view of Palefsky et al (D452,797). Turner discloses the invention except for the cross section of the tumbler being non-circular. Palefsky et al discloses a tumbler with a cross-section in the lower area of a rounded polygon. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of a rounded polygon cross-section as disclosed by Palefsky et al in the tumbler disclosed by Turner to provide for a better gripping surface and make the tumbler more attractive.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry A. Grosso whose telephone number is 571-272-4539. The examiner can normally be reached on Monday through Thursday from 7am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on 571-272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Nathan Newhouse  
Supervisory Patent Examiner  
Art Unit 3727

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